

## IN THE UNITED STATES PATENT AND TRADEMARK (

TRANSMITTAL LETTER (GENERAL)  
(With Certificate of Mailing by First Class Mail)

Applicant/Registrant: Sybaritic, Inc. v. Thomas P. Muchisky  
Serial No.: 78/282,661  
Registration No.:  
Trademark: MISCELLANEOUS DESIGN

Docket No.  
Opp. No. 91163999

TO THE COMMISSIONER FOR TRADEMARKS:

Transmitted herewith is the following:

**Opposer's Reply in Support of Its Rule 56(f) Motion and Declaration  
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Signature

Dated: February 17, 2006

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451" [37 CFR 1.8(a)] on

February 17, 2006

(Date)

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Kim Dorsey

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**IN THE UNITED STATES PATENT & TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SYBARITIC, INC.,	)	
	)	
Opposer,	)	Opposition No.: 91163999
	)	Serial No. 78/282,661
vs.	)	
	)	
THOMAS P. MUCHISKY,	)	
	)	
Applicant.	)	

**OPPOSER'S REPLY IN SUPPORT OF ITS  
RULE 56(f) MOTION AND DECLARATION**

**I. INTRODUCTION**

Federal Rule of Civil Procedure 56(f) “provides a built-in safeguard to prevent a rush to judgment or prematurely deciding a case before trial” by allowing the non-movant to conduct discovery related to issues asserted in a motion for summary judgment. See T. Jeffrey Quinn, Tips from the TTAB: Discovery Safeguards in Motions for Summary Judgment, 80 Trademark Rept. 413, 414 (1990). “A typical situation where FRCP 56(f) is invoked, and the one most commonly seen by the Board in well-taken motions under the rule, is where the non-movant cannot present by Declaration facts essential to justify its opposition to the summary judgment motion because knowledge of these facts is exclusively or largely within the control of the moving party.” Id. at 415 (emphasis added).

That is exactly the case here. Opposer Sybaritic, Inc. filed its Rule 56(f) Motion and Affidavit because Applicant Thomas P. Muchisky has relied on certain facts solely within his knowledge and/or control, but at the same time has refused discovery into those facts. Opposer therefore cannot formulate its response to the Motion for Summary Judgment without leave to

conduct further discovery. Applicant's Response to the Rule 56(f) Motion confuses the issues, and Opposer therefore files the following Reply.

## **II. DISCUSSION**

Applicant states in its summary judgment papers that it "moves the Board summarily to determine whether Applicant's mark is not functional, has acquired distinctiveness and secondary meaning, and functions as a trademark." See Memorandum in Support of Applicant's Motion for Summary Judgment [hereinafter "Memorandum"] at p. 2. Applicant has refused to provide the information necessary for Opposer to refute any of the facts Applicant relies on in support of its request for summary judgment.

Specifically, in an attempt to establish acquired distinctiveness, Applicant states in his Memorandum and in his Declaration filed therewith that he has "used the mark for at least forty years." See Memorandum at p. 3; Declaration of T. Muchisky, at ¶ 8. Because Applicant has relied on this fact to obtain summary judgment, Opposer is entitled to conduct discovery regarding this fact. Opposer attempted to do so during the discovery period, but Applicant refused to produce the requested information. See Request for Admission Nos. 6-9, attached to Affidavit of Frank B. Janoski, at Ex. 1; Interrogatory Nos. 1-4, attached to Janoski Aff. at Ex. 3; Document Request Nos. 3-4, 6, attached to Janoski Aff. at Ex. 2. Then, in response to Opposer's Rule 56(f) Motion, Applicant undertakes a complete reversal and claims that his use and ownership of the trademark are not at issue in this proceeding. See Applicant's Response to Rule 56(f) Motion [hereinafter "Response"] at p. 1. Applicant cannot rely on a fact for purposes of seeking summary judgment while refusing to allow discovery regarding that fact. The Rule 56(f) Motion should be granted with regard to Applicant's use of the purported trademark.

Other facts relied on by Applicant to prove acquired distinctiveness are (1) yearly sales and (2) yearly advertising. The only evidence of these numbers is Applicant's own self-serving

Declaration. As explained in Opposer's opening Motion and Memorandum, Opposer has reason to believe that Applicant's assertions of yearly sales and advertising costs are not accurate. Opposer was diligent in requesting all of this information during the discovery period, but Applicant refused to provide any information or documents. See Document Request Nos. 5-8, attached to Janoski Aff. at Ex. 2; Responses to Requests for Production Nos. 5-8, attached to Janoski Aff. at Ex. 6; Interrogatory Nos. 17-18, attached to Janoski Aff. at Ex. 3; Responses to Interrogatory Nos. 17-18, attached to Janoski Aff. at Exhibit 5.

With regard to the sales figures, Applicant refused to produce documents on the grounds that the documents were already in Opposer's possession, purportedly from the pending federal litigation between the parties. See Responses to Requests for Production Nos. 5-8, attached to Janoski Aff. at Ex. 6. Now, in direct contradiction to his own discovery responses, Applicant stated in his Response to the Rule 56(f) Motion that the documents produced in the federal litigation are irrelevant to this proceeding. See Response at p. 2. Again, Applicant cannot have it both ways. Because Applicant is relying on the sales numbers in support of his request for summary judgment, Opposer is entitled to examine the underlying documents. Due to Applicant's refusal thus far to produce documents relating to the alleged mark at issue, additional discovery is necessary before Opposer can fully respond to this allegation in the summary judgment papers.

Likewise, with regard to the advertising numbers, the only evidence in the record is Applicant's own self-serving, conclusory Declaration. Applicant refused to provide the underlying advertising information on the basis of confidentiality. See Responses to Interrogatory Nos. 17-18, attached to Janoski Aff. at Exhibit 5. Opposer sent Applicant a proposed protective order to address the confidentiality concerns on January 20, 2006, but

Applicant has never responded. The fact that Applicant's advertising expenditures account for more than fifty percent of his gross sales tends to refute the assertions upon which Applicant bases his request for summary judgment, but without access to the underlying information (which is within the sole control of Applicant), Opposer cannot fully respond to the summary judgment motion. Opposer's Rule 56(f) Motion should therefore be granted.

With regard to the availability of alternative designs, Applicant states in his Declaration that certain attached exhibits show "several advertisements which illustrate alternative designs used by competitors. These designs, as well as others, are competing effectively without copying Applicant's design." Muchisky Decl. ¶ 13 (emphasis added). Applicant relies on this purported fact in an attempt to prove that the trademark design sought to be registered is not functional. See Memorandum at p. 5. Applicant previously refused to answer interrogatories on this issue on the ground that the information would not lead to discoverable evidence. See Response to Interrogatory No. 10, attached to Janoski Aff. at Ex. 5. Then, after Opposer requested to conduct discovery into these alleged facts in order to respond to Applicant's Motion for Summary, Applicant claimed that Opposer should somehow already be aware of such alternative designs and that Applicant should not be required to perform an "investigation" into the assertion. See Response at p. 2-3. As with the other categories, Applicant cannot rely on a fact for the purposes of summary judgment while refusing discovery into that very same fact. Discovery into alternative designs should be allowed before any response to the summary judgment motion is required to be filed.

Finally, Applicant states in his Declaration in support of his request for summary judgment that "Applicant's design does not result from a comparatively simple or inexpensive method of manufacture." See Muchisky Decl. ¶ 15. Applicant then expressly relied on this

statement in his request for summary judgment on the issue of functionality. See Memorandum at p. 5. In response to Opposer's request to conduct discovery on this issue before responding to the summary judgment motion, Applicant stated "there is no evidence in the record that Applicant's design results from a comparatively simple or inexpensive method of manufacture, and in fact does not result from a simple or inexpensive method of manufacture." See Response at p. 3. There is no evidence in the record because Applicant has refused to produce any such evidence in response to previously propounded discovery on this very issue even though this information is solely within Applicant's control. See Muchisky Response to Request for Production Nos. 11-13, attached to Janoski Aff. at Ex. 6. Because Opposer cannot respond to the summary judgment motion without discovery into Applicant's method of manufacture, the Rule 56(f) Motion should be granted.

Applicant's refusal to provide information and documents during the discovery period and subsequent reliance on the very same information (without underlying documentary support) as the basis for his summary judgment motion has made Opposer's present Rule 56(f) request for additional discovery necessary. Because (1) Applicant's usage of the alleged trademark design sought to be registered; (2) Applicant's yearly sales related to the alleged trademark design; (3) Applicant's yearly advertising related to the alleged trademark design; (4) purported alternative designs; and (5) method of manufacture of the alleged trademark are asserted and relied on by Applicant in his request for summary judgment, Opposer should be allowed to conduct discovery into the facts before being required to respond substantively to the summary judgment motion.

### **III. CONCLUSION**

For the reasons stated herein and the reasons set forth in Opposer's Motion and Memorandum pursuant to Rule 56(f) and supporting Declaration, Opposer respectfully requests that the Board grant it sufficient additional time, at least sixty (60) days, in which to obtain or

otherwise conduct discovery (after relevant documents are produced) regarding (a) Applicant's usage of the alleged trademark applicator design sought to be registered, (b) Applicant's purported sales of the applicator in question, (c) Applicant's purported advertising costs with respect to the applicator in question, (d) Applicant's knowledge of alleged alternative designs, and (e) Applicant's knowledge of the comparative simplicity and expense for the method of manufacture for the design in question, and any other issues relating to Applicant's Motion or production of documents. Opposer Sybaritic, Inc. further requests additional time from the end of this Rule 56(f) discovery period, or at least thirty (30) days, in which to file a response to Applicant's Motion for Summary Judgment, and for such other and further relief as the Board deems just and proper.

Respectfully submitted,

**LEWIS, RICE & FINGERSH, L.C.**

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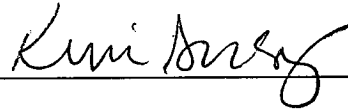
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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing **OPPOSER'S REPLY IN SUPPORT OF ITS RULE 56(f) MOTION** was served, via U.S. Postal Service, first class postage prepaid, this 17th day of February, 2006, upon the following:

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